

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Sergei Lukyanov **ANATOLIEVICH**, et al.

Serial No.: 10/532,681

Group No.: 1632

Filed: February 20, 2007

Examiner: W.C.W. Shen

Confirmation No.: 6233

For: FLUORESCENT PROTEINS AND CHROMOPROTEINS FROM
NON-AEQUOREA HYDROZOA SPECIES AND METHODS FOR
USING SAME

Mail Stop Sequence

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

**SUBMISSION OF "SEQUENCE LISTING," COMPUTER READABLE COPY,
AND/OR AMENDMENT PERTAINING THERETO
FOR BIOTECHNOLOGY INVENTION CONTAINING NUCLEOTIDE
AND/OR AMINO ACID SEQUENCE**

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

- ☐ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

FACSIMILE

- ☐ transmitted by facsimile to the Patent and Trademark Office to **(571) 273-8300**

EFSS WEB

- ☒ transmitted electronically

Date: August 31, 2009

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

(check and complete this item, if applicable)

1. ☒ This replies to the Office Letter dated July 27, 2009.

NOTE: If these papers are filed before the office letter issues, adequate identification of the original papers should be made, e.g., in addition to the name of the inventor and title of invention, the filing date based on the "Express Mail" procedure, the serial number from the return post card or the attorney's docket number added.

☒ A copy of the Office Letter is enclosed.

IDENTIFICATION OF PERSON MAKING STATEMENT

2. I, CLIFFORD J. MASS
(type or print name of person signing below)

state the following:

ITEMS BEING SUBMITTED

3. Submitted herewith is/are

(check each item as applicable)

- A. ☒ "Sequence Listing(s)" for the nucleotide and/or amino acid sequence(s) in this application. Each "Sequence Listing" is assigned a separate identifier as required in 37 C.F.R. 1.821(c) and 37 C.F.R. 1.822 and 1.823.
- B. ☐ An amendment to the description and/or claims, wherein reference is made to the sequence by use of the assigned identifier, as required in 37 C.F.R. 1.821(d).
- C. ☒ A copy of each "Sequence Listing" submitted for this application in computer readable form, in accordance with the requirements of 37 C.F.R. 1.821(e) and 1.824.
- D. ☐ Please transfer to this application, in accordance with 37 C.F.R. 1.821(e), the computer readable copy(ies) from applicant's other application identified as follows:

NOTE: "If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate readable form in the new application. The new application shall be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified." 37 C.F.R. § 1.821(e).

In re application of:

Serial No.:

Filed:

For:

Group No.:

Examiner:

The Computer readable form(s) of applicant's other application corresponds or compares to the "Sequence Identifier(s)" of this application as follows:

Computer Readable Form
(other applications)

"Sequence Identifier"
(this application)

E. ☐ A statement that the content of each "Sequence Listing" submitted and each computer readable copy are the same, as required in 37 C.F.R. 1.821(f).

☐ Because the statement is not made by a person registered to practice before the Office, the Statement is verified as required in 37 C.F.R. 1.821(b).

F. ☐ Because this submission is made in fulfilling the requirement under 37 C.F.R. 1.821(g), a statement that the submission includes no new matter.

☐ Because the statement is not made by a person registered to practice before the Office, the statement is verified, as required in 37 C.F.R. 1.821(g).

**STATEMENT THAT "SEQUENCE LISTING"
AND COMPUTER READABLE COPY ARE THE SAME
AND/OR THAT PAPERS SUBMITTED INCLUDES NO NEW MATTER**

4. I hereby state:

(complete applicable item A and/or B)

A. ☒ Each computer readable form submitted in this application, including those forms requested to be transferred from applicant's other application, is the same as the "Sequence Listing" to which it is indicated to relate.

B. ☒ All papers accompanying this submission, or for which a request for transfer from applicants' other application, introduce no new matter.

STATUS

5. Applicant is

☒ a small entity:

☐ other than a small entity.

EXTENSION OF TERM

6.

NOTE: 37 C.F.R. § 1.704(b)". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of Dec. 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. 1.645 for extensions of time in interference proceedings and 37 C.F.R. 1.550(c) for extensions of time in reexamination proceedings.

7. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b) as applicable)

(a) ☒ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input checked="" type="checkbox"/> one month	\$ 130.00	\$ 65.00
<input type="checkbox"/> two months	\$ 490.00	\$ 245.00
<input type="checkbox"/> three months	\$ 1,100.00	\$ 555.00
<input type="checkbox"/> four months	\$ 1,730.00	\$ 865.00
	Fee \$ <u>65.00</u>	

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured, and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

FEE PAYMENT

8. ☐ Attached is a check in the sum of \$ _____.

- ☒ Charge Account No. 12-0425 the sum of \$ 65.00.
A duplicate of this transmittal is attached.

FEE DEFICIENCY

9.

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

10. ☒ If any additional extension and/or fee is required, charge Account No. 12-0425.

SIGNATURE(s)

(type or print name of person signing statement)

Signature

Date

P.O. Address of Signatory

(If applicable)

Tel. No.:

Reg. No.

- ☐ Inventor
☐ Assignee of complete interest
☐ Person authorized to sign on behalf of assignee
☒ Practitioner of record
☒ Filed under Rule 34(a)
☐ Registration No. _____
☐ Other _____
(specify identity of person signing)

(complete the following, if applicable)

(type name of assignee)

Address of assignee

Title of person authorized to sign on behalf of assignee

A "STATEMENT UNDER 37 C.F.R. 3.73(b)" is attached.

Assignment recorded in PTO on _____
Reel _____ Frame _____

Reg. No.: 30086

Tel. No.: (212) 708-1890

Customer No.:



00140

PATENT TRADEMARK OFFICE

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/532,681	02/20/2007	Sergei Anatolievich Lukyanov	U 015745-9	6233												
<div>140 7590 07/27/2009</div> <div>LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023</div> <div>RECEIVED JUL 30 2009 L & P LLP</div> <div><table border="1"><thead><tr><th colspan="2">EXAMINER</th></tr></thead><tbody><tr><td colspan="2">SHEN, WU CHENG WINSTON</td></tr></tbody></table><table border="1"><thead><tr><th>ART UNIT</th><th>PAPER NUMBER</th></tr></thead><tbody><tr><td>1632</td><td></td></tr></tbody></table><table border="1"><thead><tr><th>MAIL DATE</th><th>DELIVERY MODE</th></tr></thead><tbody><tr><td>07/27/2009</td><td>PAPER</td></tr></tbody></table></div>					EXAMINER		SHEN, WU CHENG WINSTON		ART UNIT	PAPER NUMBER	1632		MAIL DATE	DELIVERY MODE	07/27/2009	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/532,681

Examiner

WU-CHENG Winston SHEN

Applicant(s)

LUKYANOV ET AL.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on *15 May 2009* is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☒ C. Other See Continuation Sheet.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

/Wu-Cheng Winston Shen/
Patent Examiner, Art Unit 1632

Continuation of 1(c) Other: With regard to sequence compliance, the file on the CRF disk filed by Applicant on 05/14/2009 could not be read or processed by the Office computer. The sequence rules specify that the file must be saved in ASCII text format only. "37 CFR 1.824(a)(2) The "Sequence Listing" in paragraph (a) (1) of this section shall be submitted in American Standard Code for Information Interchange (ASCII) text. No other formats shall be allowed." Applicant needs to resend the CRF disk with the file saved in the proper ASCII text format.